SUPREME COURT, U. S.

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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1960

No. 182

GEUDER, PAESCHKE & FREY CO.,
a corporation,

Petitioner,

vs.

JOHN R. CLARK,
and
J. R. CLARK COMPANY,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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Petitioner prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit entered in the above entitled case on March 30, 1961.

OPINIONS BELOW

The opinion of the Court of Appeals for the Seventh Circuit entered March 30, 1961 is reported at 288 F. 2d 1 (1961). The opinion of the District Court for the Eastern District of Wisconsin is reported at 26 FRD 223 (1960) and also appears at pages 99-108 of the printed Appendix filed in the Court of Appeals. Copies of the opinion and judgment of the Court of Appeals are attached hereto as Supplements A and B respectively.

JURISDICTION

The jurisdiction of this Court is invoked under 28 USC § 1254(1).

QUESTION PRESENTED

In this independent action petitioner sought to restrain the respondents Clark from obtaining a money judgment for the infringement of Claim 1 of Olander Patent No. 2,663,102 which issued on an application filed June 9, 1950 and was held valid (259 F. 2d 737) as covering an ironing board with a supporting leg structure offset from the center of the board to provide knee room, because the same invention, described in Claim 14 of Hortman Patent No. 2,896,347, was subsequently held patentable (264 F. 2d 911), said Hortman patent, however, issuing on a prior application filed April 12, 1950. Said two claims, except for the colored underscoring, read as follows:

OLANDER CLAIM 1	HORTMAN CLAIM 14
In an ironing table having an elongated ironing board,	In an adjustable and collapsible ironing table, a relatively long and narrow table top to be positioned at various heights, including low heights for sit-down ironing, during use of the table,

a supporting structure for the board comprising a front leg member and a rear leg member

respectively secured at longitudinally spaced points to the underside of the board

and extending angularly downwardly to cross each other at a point above their longitudinal centers whereby the lower ends of the leg members will be spread further apart than their upper ends,

said members consisting of single bars pivoted together at their intersection

and with their parts above the intersection lying adjacent to the vertical longitudinal plane of one lateral edge of the board, and

the lower ends of the leg members having rigid transverse extensions underlying the table to support the table against lateral tilting. (A. 5)

a supporting structure comprising a pair of legs

pivotally interconnected intermediate their ends and extending lengthwise of the table,

said supporting structure being of sufficiently narrower width than said top,

and being laterally offset in relation to the longitudinal axis of said top sufficiently, at least in those portions to be disposed in the vicinity of the user's knees, to provide room for the knees opposite said portions beneath the top and thereby permit use of the table for sit-down ironing,

a fixed pivot connection between said top and one of said legs, a sliding pivot connection between said top and the other leg to enable adjustment and collapse of the table, manually-controllable means for retaining the slidable pivot in different positions when the table is set up for use, enabling the positioning of said top at various heights including low heights for sit-down ironing, and

feet portions on said legs constructed to provide stable support for the ironing table despite the aforementioned laterally offset relation. (A. 8-9)

Did the Court of Appeals err when it denied leave to the District Court to entertain this independent action (288 F. 2d 1) by disposing of the issue as to the identity of invention with the following inadequate conclusory comment:

> "Although the phraseology of Claim 14 of the Hortman Patent and Claim 1 of the Olander Patent are, in some respects, similar, there are important differences. The two claims are directed to different concepts and combinations of elements. Claim 14 of the Hortman Patent does not respond to certain limitations contained in Claim 1 of the Olander Patent."

CONSTITUTIONAL PROVISION AND STATUTES INVOLVED

Article I, Section 8, Clause 8 of the United States Constitution:

> "The Congress shall have power * * * To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

35 USC § 102:

> "A person shall be entitled to a patent unless—
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
> * * *
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent,"

35 USC § 103:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

STATEMENT OF THE CASE

An interlocutory judgment entered by the District Court in a prior case between the parties held Claim 1 of Olander Patent No. 2,663,102 valid and infringed. See 159 F. Supp. 948. Such judgment was affirmed by the Court of Appeals. See 259 F. 2d 737.

This is an independent action seeking to enjoin Clark, plaintiffs in the prior case and respondents here, from proceeding further to a money judgment on the grounds that 1) *subsequent to said affirmance*, Patent No. 2,896,347 issued on July 28, 1959 to one Hortman, 2) Hortman Claim 14 was for the same invention as Olander Claim 1, both claims being directed to the combination of an ironing table top supported by a leg structure offset from the middle of the table top to provide knee room for sit-down ironing as well as being adjustable for stand-up ironing by persons of different heights, and 3) Hortman as inventor filed his application prior to the filing of the Olander application and Clark, as Olander's assignee, has elected to stand on the Olander filing date as the date of his alleged invention.

Olander Claim 1 was judicially interpreted in the prior case between the parties (159 F. Supp. 948 and 259 F. 2d

737) and Hortman Claim 14 was judicially interpreted by the Court of Customs and Patent Appeals in *Application of Hortman*, 264 F. 2d 911 (CCPA 1959). The other material facts stated chronologically are as follows, with references to the printed Appendix in the United States Court of Appeals for the Seventh Circuit being noted as (A. .....):

April 12, 1950

Hortman filed his patent application on an ironing table (A. 21) with the supporting legs "not at the center of the ironing table top, thus providing a greater amount of knee room on one side of the ironing table for the convenience of the user when it is desired to iron in the sitting position" (A. 23, Col. 6, lines 2-5) and claiming "An adjustable height ironing table, * * * said supporting members as an assembly being offset from the longitudinal axis of the table top to provide more clearance on one side of the table than on the other, * * *." (A. 111)

June 9, 1950

Olander filed his patent application. (A. 7, 97)

Dec. 22, 1953

Patent No. 2,663,102 issued to Olander with sixteen claims, including Claim 1 involved herein. (A. 97)

May 12, 1954

Respondents Clark filed suit in the United States District Court for the Eastern District of Wisconsin against Petitioner (GP&F) for infringement of Claim 1 only of said Olander patent.

Sept. 11, 1956

A Stipulation was filed in the prior case in which "the parties agreed that the only issues to be presented for

trial * * * " as to validity were whether Claim 1 of the Olander Patent No. 2,663,102 was rendered invalid by the Busch, Pope or Lowenberg patents or by the "Mary Proctor" ironing table made by the Proctor Electric Company and sold August 25, 1949. (A. 68, 69)

January 28-29, 1957

During trial of the prior case counsel for GP&F stated that the "Mary Proctor" board stipulated to have been sold August 25, 1949 was relied upon as prior art because as of then "no date of invention by Olander has been carried back prior to the date of the filing of his application * * * " on June 9, 1950, counsel for Clark stating "That's quite understandable and agreeable", and counsel for each party acknowledging ignorance of what was happening in the Patent Office on a Hortman patent application, referred to in a patent issued to Hild, Clark's counsel commenting "I assumed it was abandoned quite a long time ago." (A. 70)

Dec. 19, 1957

On the basis of the evidence presented (A. 108), the District Court held Olander Claim 1 valid and infringed by GP&F. (159 F. Supp. 948)

Oct. 10, 1958

Validity of Olander Claim 1 was affirmed by the Seventh Circuit Court of Appeals. (259 F. 2d 737)

Feb. 24, 1959

Certiorari denied by this Court, Mr. Justice Douglas noting his view that certiorari should be granted. (359 U. S. 914)

April 13, 1959

A Special Master was appointed for the accounting in the prior case, which is presently pending in the District Court. (A. 7)

May 4, 1959

There was published at 121 USPQ 218 the decision of the Court of Customs and Patent Appeals reversing the Patent Office and holding that what is now Claim 14 of Hortman Patent No. 2,896,347 defined patentable subject matter. The decision also is reported as *Application of Hortman,* 264 F. 2d 911 (1959).

July 28, 1959

Patent No. 2,896,347 containing said adjudicated Claim 14 issued to Hortman on his application filed April 12, 1950, and the entire Hortman file wrapper for the first time became available to counsel for GP&F. (A. 76)

Aug. 12, 1959

This independent action was instituted to enjoin respondents Clark from enforcing the interlocutory judgment in the prior case because Hortman Claim 14 had a prior application date, and described the same invention as, that described in Olander Claim 1.

August 1, 1960

The District Court dismissed this independent action on the ground it lacked jurisdiction to consider the complaint on its merits because GP&F had not first obtained from the Court of Appeals leave to commence such action. (26 FRD 223)

March 31, 1961

The Court of Appeals affirmed said District Court ruling but also held that granting GP&F such leave would be a useless gesture. (288 F. 2d 1)

REASONS FOR GRANTING THE PETITION FOR WRIT OF CERTIORARI

This independent action is based on the issuance, *after affirmance* by the Court of Appeals of the interlocutory judgment in the prior case, of United States Letters Patent No. 2,896,347 on Hortman's application filed prior to the Olander application, Claim 14 of which describes the same invention as that described in Olander Claim 1. Since respondents Clark elected not to carry Olander's date of invention back to his later filing date, and the respective dates of invention are the filing dates in the absence of other proof,[1] the invention described in Hortman Claim 14 is prior to that described in Olander Claim 1.

It is well established that only one valid patent can be issued for a single invention, *Miller v. Eagle Manufacturing Co.*, 151 U.S. 186 (1893), and the right to such grant is in the first inventor. *Coffin v. Ogden*, 19 Wall. (85 U.S.) 120 (1874) and 35 USC § 102(a). Accordingly, if Hortman Claim 14 and Olander Claim 1 are for the same invention, the judgment of the Court of Appeals sought to be reviewed validates two outstanding patents for the same invention in contravention of Article I, Section 8, Clause 8 of the United States Constitution and the statutes.

The enforcement of the constitutional and statutory prohibition against such a situation involves a matter of public policy in which the public interest is paramount and dominant. See *Edward Katzinger Co. v. Chicago Metallic Mfg. Co.*, 329 U.S. 394, 400 (1947) and *Mercoid Corp. v. Mid-Continent Investment Co.*, 320 U.S.

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[1] *Sundh Electric Co. v. Interborough Rapid Transit Co.*, 198 F. 94 (2d Cir. 1912) and *Automatic Weighing Machine Co. v. Pneumatic Scale Corp.*, 166 F. 288 (1st Cir. 1909).

661, 665 (1944). Manufacturers of ironing tables now stand exposed to charges of infringement from the owners of each of the outstanding Olander and Hortman patents, although the monopoly conferred by a patent can constitutionally be granted only on the basis of an intended public benefit from such monopoly. Where no such benefit can occur, for the reason the invention is taught by another, the public interest requires the striking down of the invalid patent mistakenly issued to the subsequent "inventor" and by enjoining the enforcement of judgments based on such void patent.

Petitioner respectfully submits that the requested Writ of Certiorari should issue in the public interest. The District Court did not rule upon the issue of whether Olander Claim 1 and Hortman Claim 14 are for the same invention and the statement by the Court of Appeals that there are "important differences" is a mere conclusion. The Court of Appeals did not, and a mere reading of the two claims set forth above demonstrate that it could not, specify in its opinion detailed or evidentiary support for its conclusion.

A READING OF OLANDER CLAIM 1 AND HORTMAN CLAIM 14 DISCLOSES THAT THEY DESCRIBE THE SAME INVENTION

The following comparison of the two claims, which are set forth side by side at pages 2-3 hereof, demonstrates that they contain corresponding recitals of like elements:

1. Each claim commences by reciting the usual "elongated ironing board" (Olander) or "relatively long and narrow table top" (Hortman).

2. Each claim continues by calling for "a supporting structure" of two legs, Olander calling his legs "a front leg member and a rear leg member" and Hortman reciting "a pair of legs".

3. Olander next secures his legs "at longitudinally spaced points to the underside of the board," and Hortman recites "a fixed pivot connection" and a "sliding pivot connection" between his legs and the table top. Hortman recites more detail in this portion of his claim but the Court of Customs and Patent Appeals specifically stated that this did not distinguish from the prior art and was not a part of the inventive thought. See 264 F. 2d 911 at 913.

4. Olander's fourth recital is that his legs extend "angularly downwardly to cross each other at a point above their centers". Hortman describes the same structure as a pair of legs "pivotally interconnected intermediate their ends and extending lengthwise of the table," and this obviously will result in an angular downward disposition with a crossing of the two legs, just as Olander recited. As for crossing at a point above the leg centers, the Hortman drawings show this concept (A. 15) which also is notoriously old (see King Patent No. 260, 210, at A. 41; Rock Patent No. 431, 530 at A. 47; and Northrup Patent No. 1, 161, 407 at A. 49).

5. Olander continues by reciting that his members each consist "of single bars pivoted at their intersection". Such pivoted connection was recited in a previous part of Hortman's claim and he matches the single bar recitals with the statement "said supporting structure being of sufficiently narrower width than said top". Here we see that each applicant is reciting a leg structure of sufficiently narrow width, with the result that knee room will be

obtained when the leg structure is offset from the center of the table top. Hortman discloses in his drawings one single bar leg and one double bar leg but the selection of two single bar legs, as Olander recites, is a mere matter of choice.

6. Olander then positions the parts of his legs above their intersections "adjacent to the vertical longitudinal plane of one lateral edge of the board." Hortman closely parallels this by reciting, *in broader language,* that his legs are "laterally offset in relation to the longitudinal axis of said top sufficiently, at least in those portions to be disposed in the vicinity of the user's knees, to provide room for the knees". Here each inventor is moving his leg structure laterally from the center line of the table top to obtain the knee room, which, as hereinafter discussed, has been judicially interpreted in the case of both Hortman Claim 14 and Olander Claim 1 to be the essence of their inventive thought. Olander's specific amount of offset to the edge is admittedly old (A. 93) as shown in Lowenberg (A. 55). It does not distinguish inventively.

7. Each claim closes with a recital of transverse feet at the lower end of the legs to provide stability. Olander recites "rigid transverse extentions * * * to support the table" and Hortman reads "feet portions * * * to provide stable support."

Manifestly both claims are directed to the same concept of providing knee room through employment of a narrow leg structure offset to one side of the longitudinal center of the table top and comprised of angularly crossed legs pivoted to one another and with transverse feet for stability.

The Judicial Interpretations

a) Hortman Claim 14 was rejected by the Patent Office for failure to define invention over the prior art and the Court of Customs and Patent Appeals, in reversing the Patent Office, discussed the contents of such claim at length. That Court, in determining that Hortman Claim 27 (ultimately renumbered claim 14) defined patentable invention, specifically noted that the invention lay in offsetting the leg structure for facilitating sit-down ironing:

> "On the other hand, we do not agree with the board that inventive faculty is lacking in appellant's recitation in each claim on appeal of the
>
> > "'* * * supporting structure being of sufficiently narrower width than said top and being laterally offset in relation to the longitudinal axis of said top sufficiently, at least in those portions to be disposed in the vicinity of the user's knees, to provide room for the knees opposite said portions beneath the top and thereby permit use of the table for sit-down ironing, * * *.'" (264 F. 2d 911, 913, 914)
>
> "We are of the opinion that the element of laterally offsetting the supporting structure in relation to the longitudinal axis of the ironing board top, in order to create more knee space, is a feature that would not be suggested to one skilled in the art from a consideration of the primary references in the light of the Lowenberg disclosure." (264 F. 2d 911, 914)

The Court of Customs and Patent Appeals further noted that portions of the claim language were for old well known elements that did not pertain to the inventive contribution:

> "Some of the claimed features alleged by appellant to be novel are anticipated by the references. Adjustable means providing for a wide range of

> positions of the ironing table top are disclosed in the King, Rock and Northrup patents. Although the extent of adjustment differs in each reference, the basic principle is the same. Therefore, the broad recitation of this element in the appealed claims cannot be relied upon to distinguish over the prior art. Likewise, the feature of extending the feet to 'provide stable support for the ironing table' is of obvious applicability to any table, as shown, for example, by Lowenberg." (264 F. 2d 911, 913)

It is clear from the foregoing that a patent for Hortman Claim 14 was finally granted because of the offsetting of a narrow leg structure to one side so as to secure knee room for sit-down ironing.

b) The judicial interpretation of Olander Claim 1 in the prior case indicates that the validity of such claim also was sustained only because of such an offset leg structure to secure knee room for sit-down ironing. The Court of Appeals for the Seventh Circuit in such case discussed the problem of ironing in the following language at 259 F. 2d 737 at page 738:

> "The principal reason why hand-ironing was so tiring was that the housewife had to stand while ironing, or sit on a high stool with her knees either spread apart or twisted to one side because of the interfering leg structure of the ironing table. There are some types of ironing where the housewife prefers to stand, *but usually ironing can be more comfortably accomplished while sitting,* provided the table can easily be lowered to a level where the housewife can work from an ordinary chair, *and provided the supporting structure is so designed* that she can sit with her *knees in a normal forward position* and *with the surface of the table brought completely over her lap* so she need not bend forward while working." (Italics supplied)

The Court of Appeals in the prior case resorted to the doctrine of equivalents in deciding the infringement issue and held that the GP&F board, in which the leg structure was not contiguous with nor intersected by the vertical plane passing through the lateral edge of the table top as called for in Olander Claim 1, achieved "Practically the same result * * * for there is only three-eights of an inch difference in *knee room* or *leg space* between the two tables." (259 F. 2d 737, 740—italics supplied)

The Court of Appeals also affirmed the following Finding of Fact made by the District Court:

> "11. The ironing table shown and described in the Olander patent is so constructed that it can be readily adjusted to various sit-down and stand-up positions, to accommodate short or tall operators, the supporting structure including pivotally connected single bar leg members the upper portions of which are disposed adjacent to the vertical plane of one lateral edge of the top member, providing knee and leg space so that the operator can position the top member directly and fully over her lap; while the leg members are pivoted above their longitudinal centers so as to span a wide floor supporting area and thus form a rigid supporting structure for the top member regardless of the elevation to which it is adjusted." (159 F. Supp. 948, at 949)

It is apparent from the judicial history that the inventive concept in the two outstanding patents resides in the same catalog of elements for providing knee room for sit-down ironing. Only Hortman, as the first inventor, is entitled to a patent monopoly on such invention. Thus enforcement of a judgment based on Olander Claim 1 should be enjoined for to permit Olander or his assignee to exact a toll, and to continue to do so from others, on a void patent is unconscionable.

Differences Between the Claims are Non-inventive

The Court of Appeals for the Seventh Circuit held at 288 F. 2d page 4 in the present case:

> "Although the phraseology of Claim 14 of the Hortman Patent and Claim 1 of the Olander Patent are, in some respects, similar, there are important differences. The two claims are directed to different concepts and combinations of elements. Claim 14 of the Hortman Patent does not respond to certain limitations contained in Claim 1 of the Olander Patent."

No other enumeration of the so-called "important differences" in language was made by the Court.

We submit that any existing differences in the claim language are no more than the natural product of two attorneys independently striving to define the same invention. They also are clearly insignificant in the field of patent law.

The principal differences in claim language are (1) language in Hortman pertaining to the pivoted connections and controllable means for retaining the pivot in different positions to obtain adjustable height, and (2) narrower recitals in Olander of single bar legs offset to the very edge of the table. As noted on pages 13-14 hereof, the Court of Customs and Patent Appeals concluded with respect to the first difference that the adjustable heights and manner of attaching the legs to the underside of the table are old as shown in the art and that no invention resided therein. With respect to the second difference, Clark's counsel has admitted that these elements are each old in the art as taught by Lowenberg (A. 91, 96) and to substitute an old, known element into the Hortman combination cannot be an inventive distinction that

saves Olander Claim 1. See also *In re Weber*, 88 F. 2d 489, 491 (CCPA 1937)

Consequently, even when considering the differences between the claim language, the validity of each claim in terms of invention must be based upon the same concept of offsetting a narrow leg structure to obtain knee room for sit-down ironing.

To sustain Olander Claim 1 it must be found patentable over the invention of the prior inventor Hortman. This involves application of 35 USC § 103, a codification of the rule of *Hotchkiss v. Greenwood*, 11 How. (52 U.S.) 248 (1850) which states:

> "* * * for unless more ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to the clay or porcelain knob than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skillful mechanic, not that of the inventor."

The Court of Appeals apparently overlooked this test and the case of *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950) which held that a patent for a combination of old elements may be granted only when such elements perform a new or different function than they perform out of combination. Such a finding was not and could not be made in this case. The old elements of Olander correspond element for element with the Hortman elements and no new function or result is obtained by Olander, but rather his intended result is identical to that of Hortman.

Patents issued on copending-prior filed applications may be used as a reference in deciding the question of invention. See *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926), *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259 (1941) and 35 *USC* § 102 (e). Thus the Hortman patent with its express claims are part of the prior art over which Olander Claim 1 must patentably distinguish. The differences in the Olander claim clearly do not meet the standard of invention, for Olander only involves (1) substituting the known use of two single bar legs into the Hortman teaching, and (2) a mere increase in the offset of the legs to a degree also already known in the table art. These simple alterations were both old with Lowenberg and it takes only modest mechanical skill to make such changes. The changes are both intimated by Hortman, since he shows a single bar leg and he does not limit the degree of offset. In fact Olander Claim 1 only presents a limited version encompassed by Hortman Claim 14.

The decision of the Court of Appeals certainly does not resolve the conflict between Hortman Claim 14 and Olander Claim 1 by merely noting that there are some differences *in language* as to concepts, combination of elements and limitations. As was said by Judge Manton in his dissent in *International Signal Co. v. Vreeland Apparatus Co.*, 278 Fed. 468 (2d Cir. 1921) at pages 474-475:

> "* * * The rule of construction in a proceeding of this kind forbids the outstanding of two grants of patents for the same invention. Such a situation is created where the same inventive thought is described in two patents in quite different language. It was this view which has led to a great number of decisions which find infringement or lack of infringement, irrespective of the presence or absence

of the literal response to the language of the claim. Benjamin El. Co. v. Northwestern Co., 251 Fed. 291, 163 C.C.A. 444; Geoghegan v. Ernst, 256 Fed. 671, 168 C.C.A. 64; Tostevin-Cottie Mfg. Co. v. Ettinger, 254 Fed. 435, 166 C.C.A. 66; Silver Co. v. Sternau & Co., 258 Fed. 448, 169 C.C.A. 464.

> "The inquiry in the case at bar is: Did the inventors make the same contribution to the sum of human knowledge as was said in Bird v. Elaborated Roofing Co., supra? If so, the claims are for the same invention, notwithstanding the lack of similarity in language or scope or number of elements. * * * "

If there is room for even a single invention in the simple concept of offsetting bar legs with transverse feet to one side of an ironing board to permit sit-down ironing (see Lowenberg Patent No. 1,976,031 at A. 55), there certainly is no room for two patents on the subject.

CONCLUSION

In view of the foregoing, a Writ of Certiorari should issue out of this Court directed to the United States Court of Appeals for the Seventh Circuit so that the decision of said Court of Appeals filed in this matter on March 30, 1961 may be reviewed by this Court.

Respectfully submitted,

MAXWELL H. HERRIOTT

Attorney for Petitioner

SUPPLEMENT A

IN THE

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

September Term 1960—January Session 1961

No. 13144

GEUDER, PAESCHKE & FREY CO.,
Plaintiff-Appellant,
vs.
JOHN R. CLARK and J. R. CLARK COMPANY,
Defendants-Appellees.

Appeal from the United States District Court for the Eastern District of Wisconsin.

March 30, 1961

Before HASTINGS, *Chief Judge*, DUFFY, *Circuit Judge* and MERCER, *District Judge*.

DUFFY, *Circuit Judge*. Olander Patent No. 2,663,102 was issued on December 22, 1953 on a patent application filed June 9, 1950. The patent relates to ironing tables, and is particularly directed to the supporting structure for the table top.

On May 12, 1954, the J. R. Clark Company and John R. Clark (Clark) brought suit against Geuder, Paeschke & Frey Co. (GP&F) in the United States District Court for the Eastern District of Wisconsin, charging infringement of Claim 1 of the Olander patent. The District Court found Claim 1 of the patent valid and infringed.

Upon appeal to this Court, the judgment of the District Court was affirmed. *J. R. Clark Company v. Geuder, Paeschke & Frey Co.*, 7 Cir., 259 F. 2d 737. A petition for certiorari was denied on February 24, 1959. 359 U.S. 914.

The interlocutory judgment entered in the District Court contained an injunction against further infringement and adjudged that profits and damages recoverable from GP&F for patent infringement be determined by a Special Master who was appointed on April 13, 1959.

On May 4, 1959, there was published in 121 U.S.P.Q. 218, a decision of the United States Court of Customs and Patent Appeals that was released on April 21, 1959, with reference to the Hortman application.[1] The Board of Appeals of the Patent Office had rejected Claims 27 and 31 as failing to patentably distinguish over certain cited prior art patents. The Court reversed the Board of Appeals holding the two claims did define patentable subject matter. Claim 27 became Claim 14 of Hortman Patent No. 2,896,347 which was issued on July 28, 1959.

Alleging that Claim 1 of Olander Patent No. 2,663,102 is the same invention described in Claim 14 of Hortman Patent No. 2,896,347, and pointing out that the application for the Hortman patent was filed almost three months earlier than the Olander patent, plaintiff commenced this independent action seeking a permanent injunction restraining Clark from enforcing its interlocutory judgment.

Clark filed a motion to dismiss the complaint upon the grounds that 1) under the doctrine of *res judicata*, GP&F

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[1] This decision was later published as *Application of Hortman*, 264 F. 2d 911.

is bound by the judgment in the suit wherein Claim 1 of the Olander patent was found valid and infringed, and 2) the complaint failed to state a claim upon which relief could be granted, and the issuance of the Hortman patent gives rise to no defense not previously considered. Clark later filed a motion for summary judgment and supporting affidavits. Counter-affidavits were filed. The District Court held it was without jurisdiction to enjoin the enforcement of the judgment in favor of Clark and, therefore, granted Clark's motion for summary judgment.

The issue to be here resolved is whether leave of this Court is required for a District Court to exercise jurisdiction in an independent action which seeks to enjoin a party from enforcing a judgment in its favor, which judgment has been affirmed and approved by this Court.

The learned District Judge succinctly stated his reasons for believing the District Court was without jurisdiction. In his opinion he stated:

> "It is clear that had G.P.&F. moved in the original case for a new trial pursuant to Rule 60(b) of the Federal Rules of Civil Procedure, this court would have lacked jurisdiction to entertain that motion. *Butcher & Sherrerd v. Welsh, supra.* G.P.&F. contends, however, that the court can do in an independent action what it clearly could not have done in the original action, that is, nullify the effect of a judgment which was affirmed on appeal, because of newly discovered evidence.
>
> "We can see no reason for application of a different rule to independent actions than that applicable to motions for a new trial, or for holding that this court can do by indirection what it could not do directly."

Rule 60(b) Fed.R.Civ.P. provides that upon motion a party may be relieved from a final judgment for various

reasons including "newly discovered evidence which by due diligence could not have been discovered in time to move for a new trial under Rule 59(b); . . ." Based on such a reason, the motion must be made within one year after the entry of the judgment.

Rule 60(b) also provides: "This rule does not limit the power of a court to entertain an independent action to relieve a party from a judgment, order, or a proceeding, or to grant relief to a defendant not actually personally notified . . . or to set aside a judgment for fraud upon the court."

The parties to this suit seem to agree that if a judgment has not been appealed, the District Court, under certain conditions, has the power to relieve a party from a judgment, either by a motion under Rule 60(b) or by an independent suit. The controversy before us arises because the judgment of the District Court was appealed, and our Court affirmed that judgment, and our mandate was thereafter returned to and filed with the District Court.

The District Court relied principally upon three cases: *In re Potts,* 166 U.S. 263; *Butcher & Sherrerd v. Welsh,* 3 Cir., 206 F. 2d 259; and *City of Orlando v. Murphy,* 5 Cir., 94 F. 2d 426.

In the *Potts* case, *supra,* the Supreme Court relied upon and quoted as follows from *In re Sanford Fork and Tool Co.,* 160 U.S. 247, 255,

> "When a case has been once decided by this court on appeal, and remanded to the Circuit Court, whatever was before this court, and disposed of by its decree, is considered as finally settled. The Circuit Court is bound by the decree as the law of the case; and must carry it into execution, according to the mandate. That court cannot vary it, or examine it for

any other purpose than execution; or give any other or further relief; or review it, even for apparent error, upon any matter decided on appeal; or intermeddle with it, further than to settle so much as has been remanded."

In the *Welsh* case, *supra*, the case was originally tried in 1944, and plaintiff obtained a judgment. The Court of Appeals affirmed and the mandate was returned to the District Court. In 1946, defendants made a motion for a new trial on the ground of newly discovered evidence. A petition was filed with the Court of Appeals asking leave for the District Court to consider the motion. The petition was denied, and the mandate was returned to the District Court. In 1948, there was a "renewal" of the motion for a new trial. This was denied by the District Court and the Court of Appeals affirmed.

In 1952, defendants, without applying for leave of the Court of Appeals, filed another motion for a new trial, and the District Judge granted the motion. The trial judge relied upon Rule 60(b). The Court of Appeals stated, page 262:

". . . Where a judgment has been affirmed on appeal and the mandate handed down it is beyond the power of the lower court to disturb the judgment without leave of the appellate court. . . . What is here involved is an utter lack of jurisdiction to act. . . .

"Respondent contends that recent amendments to Rule 60(b) of the Federal Rules of Civil Procedure confer upon the trial court the power to grant relief from the operation of a judgment without prior approval of the appellate court. We cannot subscribe to this contention. Rule 60(b), while enlarging the power of the District Courts over judgments . . . does not confer upon District Courts the power to alter or amend a judgment which has been affirmed by this Court or the Supreme Court, for such alteration

would affect the decision of the reviewing court, which it is not within the power of the District Courts to do."

GP&F insists that these two cases do not limit the power of a District Court to enjoin enforcement of a judgment when such relief is sought in an independent action. GP&F insists that the savings clause in Rule 60(b) preserves the jurisdiction of the District Court to entertain such an independent action. The argument is made that the cases relied on by Judge Tehan are distinguishable because they involved ancillary proceedings and were not independent actions.

Ignoring the lack of any direct precedent to support GP&F's position, we think there is no reasonable basis for applying a different rule in the case of an independent action. The reasons usually cited for requiring leave of an appellate court in an ancillary proceeding are likewise applicable to an independent action. Among such reasons are, finality of judgments; absence of power in the lower court to change or revise the mandate of an appellate court, and the authority and rightful concern of an appellate court to protect the integrity of its judgments.

We hold that the District Court was correct in holding that it did not have jurisdiction to entertain the independent action without leave having first been obtained from this Court.

The second issue in this suit is the alternative request of GP&F that this proceeding be treated as one seeking from this Court leave for the District Court to entertain the independent action. In *Pickford v. Talbott*, 225 U.S. 651, 657, the Court held that a showing must be made that it would be manifestly unconscionable for the successful adversary to enforce the judgment.

If, from the record before us, we are able to determine that Hortman Patent No. 2,896,347 and Olander Patent No. 2,663,102 are not the same invention, it would be a useless gesture to grant GP&F leave to file its action in the District Court.

In the case which was here previously on appeal, the District Court held Claim 1 of the Olander Patent No. 2,663,102 was "good and valid in law." It also held the "Mary Proctor" ironing table did not suggest the invention of the patent in suit, and that the Mary Proctor table is substantially identical with the Hild Patent No. 2,546,097 which the Patent Examiner considered and rejected. We affirmed the District Court's decision.

The Mary Proctor table was manufactured by Proctor Electric Company, the assignee of the Hortman patent. Clark insists the ironing table disclosed by Hortman in Patent No. 2,896,347 is substantially, if not actually, identical with the Mary Proctor table considered by us on the previous appeal.

The decision of the United States Court of Customs and Patent Appeals (264 F. 2d 911) in allowing Hortman Claim 14, did not pass upon the validity of Claim 1 of the Olander patent. We were informed on oral argument in the case at bar that the attention of the Court of Customs and Patent Appeals was directed to the decision of this Court, sustaining the validity of Claim 1 of Olander Patent No. 2,663,102, but in the opinion of the United States Court of Customs and Patent Appeals, no mention is made of our decision. It is a legitimate inference that that Court did not intend to hold that Olander was not the inventor of the subject matter of Claim 1 of his patent.

Also to be considered is that Claim 14 of the Hortman Patent did not exist until May 3, 1957 which was nearly four years after the Olander Patent was issued.

In considering whether the enforcement of the judgment in the case here previously would be unconscionable, we may consider that GP&F vigorously litigated the issue of validity and infringement of the Olander Patent in the trial court, in this Court, and petitioned the Supreme Court for certiorari. Both the District Court and this Court noted that GP&F deliberately copied the Olander invention immediately after it appeared on the market. Also, that in the course of the litigation, GP&F sold its ironing table business to Jones & Laughlin Steel Corporation. As a result of this sale, Clark felt compelled to prosecute a new suit in the United States District Court for the Southern District of Indiana.

Although the phraseology of Claim 14 of the Hortman Patent and Claim 1 of the Olander Patent are, in some respects, similar, there are important differences. The two claims are directed to different concepts and combinations of elements. Claim 14 of the Hortman Patent does not respond to certain limitations contained in Claim 1 of the Olander Patent.

We conclude there are no reasons in equity why the enforcement of the judgment in the previous case should be restrained. Therefore, considering the instant appeal as a petition to this Court to grant leave to the District Court to entertain the independent action, such petition is denied.

Judgment

AFFIRMED.

SUPPLEMENT B

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

Chicago 10, Illinois

Thursday, March 30, 1961

Before

Hon. JOHN S. HASTINGS, Chief Judge

Hon. F. RYAN DUFFY, Circuit Judge

Hon. FREDERICK O. MERCER, District Judge

No. 13144

GEUDER, PAESCHKE & FREY CO.,
Plaintiff-Appellant,
vs.
JOHN R. CLARK and J. R. CLARK COMPANY,
Defendants-Appellees.

Appeal from the United States District Court for the Eastern District of Wisconsin.

This cause came on to be heard on the transcript of the record from the United States District Court for the Eastern District of Wisconsin, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, AFFIRMED, with costs, in accordance with the opinion of this Court filed this day.